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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,192	06/26/2000	THOMAS JUNG	SPM-290-A	9266

7590

06/07/2002

ANDREW R BASILE
YOUNG & BASILE
3001 W BIG BEAVER ROAD
SUITE 624
TROY, MI 48084

EXAMINER

MARKHAM, WESLEY D

ART UNIT	PAPER NUMBER
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1762

16

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

W-16

Advisory Action

Application No.

09/529,192

Applicant(s)

JUNG ET AL.

Examiner

Wesley D Markham

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 16 April 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Office Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1 and 3-22

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION / ADVISORY ACTION

Response to Amendment

1. Acknowledgement is made of applicant's proposed amendment D, filed as paper #15 on May 9, 2002, in which the applicant proposed to amend independent Claims 1 and 14 and cancel Claims 10 and 11. However, this amendment has not been entered because it raises new issues that would require further searching and consideration. Specifically, applicant's proposed amended independent Claims 1 and 14 would now require that the hollow-cathode glow discharge is activated by a DC voltage, a pulsed DC voltage, or an AC voltage. While this limitation has previously been present in the prosecution of the instant application in a single claim (i.e., as dependent Claim 11, which depends from "process" Claim 1), entry of this limitation would give rise to a situation in which all the process claims require that the hollow-cathode glow discharge is activated by a DC voltage, a pulsed DC voltage, or an AC voltage. This situation would require further searching and/or consideration. Further, the applicant's proposed amendment would require all of the "device" claims (i.e., Claims 14 – 22) to include a hollow-cathode glow discharge that is activated by a DC voltage, a pulsed DC voltage, or an AC voltage. This limitation has not previously been present in regards to any of the "device" claims throughout the prosecution of the application and therefore would require further searching and/or consideration.

Response to Arguments

2. Applicant's arguments filed on May 9, 2002 have been fully considered but they are not persuasive.
3. First, the applicant argues that Echizen et al. do not teach that the hollow-cathode glow discharge is activated by one of a DC voltage, a pulsed DC voltage, a low-frequency AC voltage, an intermediate frequency AC voltage, and a high-frequency AC voltage. For support, the applicant further states that Echizen et al. only use the electrically conductive substrate as an electrode for applying a bias voltage. The examiner agrees that, in some embodiments, Echizen et al. teach that the band-shaped member may serve as a bias applicator means (Col.26, lines 28 – 34). However, Echizen et al. also teach that other embodiments are possible for the bias applicator means, such as a bias bar, a plurality of bias bars, or the gas feed means (Col.25, lines 53 – 65). Importantly, Echizen et al. also teach an embodiment wherein, when the band-shaped member (i.e., the substrate) is made of an electrically conductive material, it may be directly used as an electrode for current passage (Col.28, lines 58 – 61). This is not the same embodiment as using the band-shaped member for the bias applicator means. As such, this embodiment of Echizen et al. appears to be the same embodiment both disclosed and claimed by the applicant.
4. Second, the applicant argues that Echizen et al. do not teach a hollow cathode effect, despite the hollow shape, because the dielectric tube "103" makes the movement of electrons perpendicular to the cathode surface impossible, resulting in

a reduction of ion density. In response, this appears to be speculation on the part of the applicant, as the applicant has provided no evidence to support this point. In addition, the examiner notes that the applicant's reasoning only appears to be sound in a circumstance in which the dielectric tube takes up the entire film-forming space. This is clearly not the case in Echizen et al. (see Figures 1 – 4 and corresponding descriptions). Therefore, the electrons in Echizen et al. would have had sufficient room to move perpendicular to the cathode surface and produce a high number of charge carriers, thereby providing a hollow-cathode effect as claimed by the applicant. Also, please note the applicant's specification on page 3, lines 11 – 13, in which the applicant describes a "hollow-cathode discharge" according to their invention to also include a discharge in the transition region between hollow-cathode discharge and normal discharge. This indicates that the applicant has not intended to limit their claims to a purely "hollow-cathode discharge", further supporting the examiner's position regarding the Echizen et al. reference.

5. Third, the applicant notes that another advantage of the present invention includes long-term stability and defect-free coating because no elements of the device are integrated inside of the plasma zone. In response, the examiner notes that the applicant's claims do not require that no elements of the device are integrated inside of the plasma zone. However, the examiner does note that such a limitation would initially appear to overcome the Echizen et al. reference, although further searching and/or consideration would be required.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.
7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham
Examiner
Art Unit 1762



WDM
June 4, 2002



SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700